

### **REMARKS**

Claims 38-43 and 187-213 were previously pending in this application. Claims 38, 40, 41, 187-208, 210 and 211 have been allowed.

### **Amendments to the Specification**

In response to the Examiner's request, Applicants provide herewith the amendments to the specification in proper amendment format. Applicants believe the specification is now in compliance as required.

### **Claim Rejections Under 35 U.S.C. §112, first paragraph**

The Examiner has rejected claims 39, 42, 43, 209, 212, and 213, under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. Applicants respectfully traverse the rejection.

The Examiner contends on Page 3 of Paper 19, that "the claims contain subject matter which was not described in the specification in such as way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed had possession of the claimed invention", and that the amendments made to the claims on 6/20/03 introduce new subject matter in to the application. Applicants respectfully disagree with both conclusions.

The basic requirement of the written description requirement is that the claimed invention must be described clearly enough to allow one of ordinary skill in the art to recognize that the inventors invented the claimed invention. *Vas-Cath v. Mahurkar* 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991); *Lockwood v. American Airlines, Inc.* 107 F.3d 1565, 41 USPQ2d 1961 (Fed. Cir. 1997); *In re Gosteli* 872 F.2d 1008, 10 USPQ 2d 1614 (Fed. Cir. 1989). The requirement is based on the knowledge of the skilled artisan in the particular art and the applicant must convey to one of ordinary skill in the art through the disclosure in the invention that the applicant was in possession of the claimed invention.

The legal requirement for written description described above includes the requirement that one of ordinary skill in the art recognize that the inventors invented the claimed invention. This is clearly demonstrated in the specification at page 8, line 19 through page 9, line 15, the examples section, and in figures 10-15, which provide discussion and data indicating the effects

on the claimed assay that are associated with the alteration in viscosity using PEG, carboxymethylcellulose, and low melting point agarose. Applicants submit that one of ordinary skill would clearly understand from the information provided in the specification as filed that Applicants had possession of the invention at the time of filing.

The law does not require that Applicants “teach or point out in detail that which is well-known in the art”. *Application of Myers* 410 F.2d 420, 56 C.C.P.A. 1129, 1969. Thus, the law specifies that knowledge and details that are in possession of those of ordinary skill in the art need not be taught in the application. Applicants contend that the level of skill possessed by one of ordinary skill in the art far exceeds the level required to possess the basic knowledge that a percent solution of a solid in a liquid is made by adding the solid into a volume of a liquid using a standard weight per volume ratio. Applicants respectfully assert that a percent solution of a solid in a liquid is well known in the art to be prepared on a weight per volume basis, and that the percent solution as claimed would have no alternative meaning to one of ordinary skill in the art.

Numerous examples of mixing solids such as those taught in the disclosure (e.g., low-melting point agarose, carboxymethylcellulose and polyethylene glycol [PEG]) with liquids to form solutions are found throughout the literature and patent databases. In the art of making solutions by combining a solid and a liquid, it is clear that a percent solution of the solid in the liquid is calculated on a weight per volume basis. Thus, Applicants submit that the inclusion of “w/v” in the claims does not add new matter, but rather is simply a common nomenclature format that is standard in the art.

Applicants have attached herewith copies of publications and excerpts of publications that disclose methods of making a solution using the low-melting point agarose, carboxymethylcellulose and polyethylene glycol [PEG]. Narang, R.A. et al, *Plant Physiology*, Dec. 2000, Vol. 124:1786-1799, discloses the addition of agarose to liquid medium to make the medium more solid (e.g. increase the solution’s viscosity). On page 1787, Table 1 indicates that the agarose added to the medium in a weight per volume ratio to reach the desired percent. Also, Sambrook, J., et al., Molecular Cloning: A Laboratory Manual, Cold Spring Harbor Laboratory Press, 1989, which is an example of a commonly used protocol publication, indicates at pages 6.4-6.5 that agarose a percent agarose solution is prepared by the addition of solid agarose to a liquid in a weight per volume manner to reach the desired percent solution. Similarly, U.S.

Patent 6,660,715 discloses at col. 4 line 66 through col 5, line 3, "addition of viscosity modifying agents such as water soluble polymers poly(ethylene glycol) and carboxymethylcellulose (0.1% to 10%) (w/v)), may also be used", and for each of these compounds it is clear that the percent solution is made by the addition of the solid to the liquid in a weight per volume ratio.

Applicants respectfully assert that the combination of the teaching in the specification as filed with the general state of knowledge in the art that a percent solution of a solid and a liquid is made on a weight per volume basis, would indicate to one of ordinary skill that Applicants were in possession of the claimed invention at the time of filing. Applicants respectfully request the Examiner reconsider and withdraw of the rejection of claims 39, 42, 43, 209, 212, and 213, under 35 U.S.C. §112, first paragraph.

**Allowable Subject Matter**

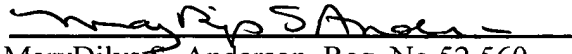
Claims 38, 40, 41, 187-208, 210 and 211 have been allowed.

**CONCLUSION**

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicants' representative at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,  
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